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EXAMINER

DENNISON, JERRY B

ART UNIT PAPER NUMBER

2143

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/810,625 | Applicant(s) TORNABENE ET AL. | |
| | Examiner J. Bret Dennison | Art Unit 2143 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is in response to Amendment for Application Number 09/810,625 received on 15 November 2004.

Claims 1-55 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10, 14-44, 54, and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Sonnenreich (U.S. Patent Number 5,974,446).

1. Regarding claim 1, Sonnenreich discloses a computer implemented method of sharing information among members of a group, the method comprising:

storing information about all current members of a group (Sonnenreich, col. 6, lines 60-67);

receiving instructions from at least one current member to invite at least one

prospective member to join the group (Sonnenreich, col. 4, lines 25-30,

Sonnenreich teaches a member being able to send an instruction to send a message to a user that is not part of the system);

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sending an invitation to the prospective member to join the group
(Sonnenreich, col. 4, lines 25-30);
receiving an affirmative response from the prospective member
(Sonnenreich, col. 4, lines 35-45);
adding the prospective member to of the group as a new member
(Sonnenreich, col. 4, lines 17-25); and
automatically updating services to current members to account for the new
member (Sonnenreich, col. 4, lines 18-25).

2. Regarding claim 2, Sonnenreich discloses the limitations, substantially as claimed, as described in claim 1, including wherein sending the invitation comprising using an e-mail message (Sonnenreich, col. 4, lines 30-35).

3. Regarding claim 3, Sonnenreich discloses the limitations, substantially as claimed, as described in claim 1, including wherein sending the invitation comprises using an instant message (Sonnenreich, col. 4, lines 35-41).

4. Regarding claim 4, Sonnenreich discloses the limitations, substantially as claimed, as described in claim 1, including wherein sending the invitation comprises using an on-line chat room (Sonnenreich, col. 4, lines 3-10).

5. Regarding claim 5, Sonnenreich discloses the limitations, substantially as claimed, as described in claim 1, including wherein receiving the affirmative

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response comprises receiving the response as an e-mail message (Sonnenreich, col. 4, lines 30-35, Sonnenreich teaches the use of email).

6. Regarding claim 6, Sonnenreich discloses the limitations, substantially as claimed, as described in claim 1, including wherein receiving the affirmative response comprises receiving the response as an instant message (Sonnenreich, col. 4, lines 35-41).

7. Regarding claim 7, Sonnenreich discloses the limitations, substantially as claimed, as described in claim 1, including wherein receiving the response comprises receiving the response in an on-line chat room (Sonnenreich, col. 4, lines 3-10).

8. Regarding claim 8, Sonnenreich discloses the limitations, substantially as claimed, as described in claim 1, including wherein automatically updating services comprises providing a list of current members that includes the new member (Sonnenreich, col. 4, lines 18-25).

9. Regarding claim 9, Sonnenreich discloses the limitations, substantially as claimed, as described in claim 1, including wherein automatically updating services comprises providing information in an address book that includes address information for the new member (Sonnenreich, col. 4, lines 30-35,

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Sonnenreich teaches sending email messages to users, inherently meaning that the chat room includes an address book).

10. Regarding claim 10, Sonnenreich discloses the limitations, substantially as claimed, as described in claim 9, including updating the address book based upon information entered by the current members of the group (Sonnenreich, col. 4, lines 18-25).

11. Regarding claim 14, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including wherein automatically updating services comprises providing an on-line forum for current members of the group to chat with other current members of the group including the new member (Sonnenreich, col. 4, lines 1-10).

12. Regarding claim 15, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including wherein automatically updating services comprises enabling current members of the group to send instant messages to other current members of the group including the new member (Sonnenreich, col. 4, lines 35-40).

13. Regarding claims 16-21, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including wherein members of the group can share data files with each other, wherein the data files include

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multimedia (Sonnenreich, col. 4, lines 44-50) and text files (Sonnenreich, col. 4, lines 1-10, 25-44).

14. Regarding claim 22, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including offering new services based upon the current members of the group including the new member (Sonnenreich, col. 4, lines 18-25, Sonnenreich teaches the a list containing the members currently online and in the group).

15. Regarding claim 23, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including wherein automatically updating services comprises providing information in an instant messaging buddy list that includes information for the new member (Sonnenreich, col. 4, lines 18-25, Sonnenreich teaches the a list containing the members currently online and in the group).

16. Regarding claim 24, Sonnenreich discloses a communication system for sharing information among members of a group including providing updated services to current members including new members and also the server processing information about the current members of the group who are online and displays a list of their names (Sonnenreich, col. 4, lines 18-30) allowing them to communicate with the group administrator (server) to deliver and exchange information (Sonnenreich, col. 4, lines 25-46), wherein in response to an

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affirmative response to an invitation to a prospective member to join the group, the group information updater is instructed by the group communicator to add the prospective member of the group (Sonnenreich, col. 4, lines 25-45).

17. Regarding claim 25, Sonnenreich discloses the limitations substantially as claimed as described in claim 24, including wherein the group administrator further comprises:

a group member profile server for updating data related to current members including the new member (Sonnenreich, col. 4, lines 18-25); and

a database connected to the group member profile server for storing data related to current members including the new member (Sonnenreich, col. 5, lines 45-57).

18. Regarding claim 26, Sonnenreich discloses the limitations substantially as claimed as described in claim 24, including wherein the group communicator further comprises:

an instant message host in communication with a client system (Sonnenreich, col. 4, lines 35-45); and

a login server in communication with a client system and the instant message host for determining whether the client is authorized to access the instant message host (Sonnenreich, col. 6, lines 60-67).

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19. Regarding claim 27, Sonnenreich discloses the limitations substantially as claimed as described in claim 26, including wherein the instant message host further comprises:

an instant message server for sending and receiving data (Sonnenreich, col. 4, lines 35-45); and

a domain server cooperating with the instant message server for providing supporting functions of the instant message host (Sonnenreich, col. 4, lines 35-45).

20. Regarding claim 28, Sonnenreich discloses the limitations substantially as claimed as described in claim 27, including wherein the instant message host further comprises a routing gateway connected to the instant message server (Sonnenreich, col. 4, lines 35-45).

21. Regarding claims 29-33, Sonnenreich discloses the limitations substantially as claimed as described in claim 24, including a login server providing a graphical user interface for members of the system. Clients must provide personal identification and information to gain access and start exchanging information (Sonnenreich, col. 6, lines 25-67).

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22. Regarding claim 34, Sonnenreich discloses a graphical user interface for inviting a prospective member of a group to join the group, the graphical user interface comprising:

- an invitation for the prospective member to join the group (Sonnenreich, col. 4, lines 25-45, Sonnenreich teaches members of the group being able to communicate to people that are not apart of the system);

- a name of the group (Sonnenreich, col. 3, lines 49-67, Sonnenreich teaching group information);

- a list of one or more current members of the group (Sonnenreich, col. 3, lines 50-60); and

- a tool for the prospective member to respond to the invitation (Sonnenreich, col. 4, lines 18-45).

23. Regarding claim 35, Sonnenreich discloses a computer program, stored on a computer readable medium, comprising instructions for:

- storing information about more than one current member of a group in a database (Sonnenreich, col. 4, lines 15-25, col. 5, lines 45-52);

- receiving instructions from at least one current member to invite at least one

- prospective member to join the group (Sonnenreich, col. 4, lines 25-45, Sonnenreich teaches users being able to contact people not using the system);

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sending an invitation to the prospective member to join the group (Sonnenreich, col. 4, lines 25-45, Sonnenreich teaches users being able to contact people not using the system);

receiving a response from the prospective member (Sonnenreich, col. 4, lines 25-45, Sonnenreich teaches users being able to contact people not using the system through email or instant message);;

adding the prospective member to the group as a new member based upon receipt of an affirmative response (Sonnenreich, col. 4, lines 15-25); and automatically updating services to current members to account for the new member (Sonnenreich, col. 4, lines 15-25).

24. Regarding claim 36, Sonnenreich discloses the limitations substantially as claimed as described in claim 35, including wherein the computer readable medium is a disc (Sonnenreich, col. 8, lines 14-16).

25. Regarding claim 37, Sonnenreich discloses the limitations substantially as claimed as described in claim 35, including wherein the computer readable medium is a client device (Sonnenreich, col. 8, lines 14-16).

26. Regarding claim 38, Sonnenreich discloses the limitations substantially as claimed as described in claim 35, including wherein the computer readable medium is a host device (Sonnenreich, col. 5, lines 45-52).

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27. Regarding claim 39, Sonnenreich discloses the limitations substantially as claimed as described in claim 35, including wherein the computer readable medium is a propagated signal (Sonnenreich, col. 8, lines 20-30).

28. Regarding claim 40, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including wherein the current members of the group comprise members of a family (Sonnenreich, col. 4, lines 15-25, Sonnenreich teaches a list of the current members of the group, wherein it is inherent that the list includes members of a family if members of a family are online and part of the group).

29. Regarding claim 41, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including wherein the prospective member comprises a relative of a current member of the group (Sonnenreich, col. 4, lines 15-25, Sonnenreich teaches a list of the current members of the group, wherein it is inherent that the list includes relatives if relatives are online and part of the group).

30. Regarding claim 42, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including in which storing information about all members of a group comprises storing information about all members of a private group (Sonnenreich, col. 3, lines 50-53).

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31. Regarding claim 43, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including in which storing information about all members of a group comprises storing information about all members of a public group (Sonnenreich, col. 3, lines 55-67).

32. Regarding claim 44, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including wherein the invitation comprises a personalized message to the prospective member (Sonnenreich, col. 4, lines 35-45).

33. Regarding claim 54, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including providing a notification of the response to one or more current members (Sonnenreich, col. 4, lines 18-25, Sonnenreich teaches the list staying current).

34. Regarding claim 55, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including treating the new member as a current member (Sonnenreich, col. 4, lines 18-25, Sonnenreich teaches the list staying current, wherein the new member becomes part of the list).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonnenreich in view of obviousness.

35. Regarding claims 11- 13, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including wherein groups that represent classes have additional features such as lectures, assignments and online discussion sessions (Sonnenreich, col. 2, last paragraph, col. 6, lines 10-15) and wherein group members contribute information to the populate the topic information database (Sonnenreich, col. 5, lines 45-50). Sonnenreich also discloses being able to send messages through instant message or email, which can be used to invite members into the group. However, Sonnenreich does not explicitly state providing information entered by group members and recorded in a calendar. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate a calendar into Sonnenreich for the benefit of group members to keep track of online discussion sessions, lectures and assignments.

Claims 45-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonnenreich in view of Simonoff (U.S. Patent Number 5,974,446).

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36. Regarding claims 45-53, Sonnenreich discloses the limitations substantially as claimed as described in claim 1, including client identification information that permits access to selected information topics (Sonnenreich, col. 5, lines 45-47). Sonnenreich does not explicitly state wherein a group founder authorizes invitations to prospective members and has the power to add and delete users from the group and promoting and demoting group members.

In an analogous art, Simonoff discloses a White Board System facilitating collaboration between a plurality of users wherein a system administrator has control over the users logged in to the system which includes the ability to delete users from the system (Simonoff, col. 24, last paragraph). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate having a group administrator to have control over the group in order for the group to be managed and the interaction between clients can be controlled (Simonoff, col. 6, lines 15-20).

Response to Amendment

Applicant's arguments and amendments filed on 15 November 2004 have been carefully considered but they are not deemed fully persuasive.

Applicant's arguments with respect to claims 1-55 have been fully considered but they are not persuasive. Applicant's arguments include the failure of previously applied art to expressly disclose the teachings of "sending an invitation to a prospective member to join the group and adding the prospective member to the group as a new member based upon receipt of an affirmative response to the invitation" [see Applicant's Response, pages 11-16]. It is evident

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from the mappings found in the above rejection that Sonnenreich discloses the teaching of groups of people with common interests. When a user logs into the system, he or she will see a toolbar containing a button for each group they belong to. All users are members of their own "private" groups. Sonnenreich discloses the teaching of users being able to send real time messages to people on the Internet that are not part of the groups. Because users have their own "private" groups, it is understood that in order for people to join a private group, they must be invited. Because Sonnenreich also provides a way of communication to users not part of the group, users are able to invite non-members to join their "private" group. The added limitation to claim 24 includes a group information updater. In order to join a group, the group list must be updated. In order for non-members of a private group to join, they must be invited. If non-members could just join the group without invitation, the group would not be "private". Further, it is clear from the numerous teachings (previously and currently cited) that the provision for "sending an invitation to a prospective member to join the group and adding the prospective member to the group as a new member based upon receipt of an affirmative response to the invitation" was widely implemented in the networking art.

Thus, Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive. It is also clear to the Examiner that Sonnenreich clearly teach the independent claims of the Applicant's claimed invention.

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Applicant's arguments with respect to claims 1-55 are deemed moot in view of the following new grounds of rejection, necessitated by Applicant's amendment to the claims, which significantly affected the scope thereof.

Furthermore, as it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Sonnenreich as well as other prior arts of records disclosed "private groups" are taught as well as other claimed features of Applicant's invention. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

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Examiner suggests Applicant to review the following new art cited with a brief explanation provided below.

Jandel et al (U.S. Patent Application Publication 2004/0030787) disclosed a private meeting room to a client group where a chairman invites other members of the group to join the new private meeting group.

Engel et al. (U.S. Patent Number 6,028,866) disclosed a system for communicating between groups of apparatuses by broadcasting invitations to apparatuses to join a group and registering communication identification which respond positively.

Beuk et al. (U.S. Patent Number 5,774,673) disclosed a system for communicating between a dynamic group of apparatuses where an apparatus invites another apparatus to join in communication by sending a message.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as

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potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571)272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703)308-5221. The

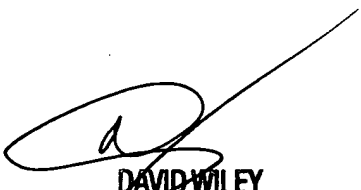
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fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. B. D.
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